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REMARKS

Claims 1-6 were previously cancelled, and claim 14 has been cancelled above. Claims 7 and 12 have been amended. Claims 8-11 and 13 remain in the application unchanged. Reexamination and reconsideration of the application are respectfully requested.

In the Office Action dated 02/16/2005, claims 7-11 and 14 were rejected under 35 U.S.C. §103(a) as being unpatentable over Munro, U.S. Patent No. 2,948,317 (hereinafter "Munro '317") in view of McCormack et al., U.S. Patent Publication No. 2002/0172574 A1 (hereinafter "McCormack et al. '574") and Allen, U.S. Patent No. 6,682,282 (hereinafter "Allen '282"). Claim 14 has been cancelled, and claim 7 has been amended above. Applicants believe that claims 7-11 are now allowable over the cited references for the reasons discussed below.

Claims 12 and 13 were rejected under 35 U.S.C. §103(a) as being unpatentable over Allen '282 in view of Swan, U.S. Patent No. 5,704,100 (hereinafter "Swan '100"). Applicants believe that these claims are now allowable over the cited references for the reasons discussed below.

Legal Standard for Claim Rejection Under 35 U.S.C. §103

The test for obviousness under 35 U.S.C. §103 is whether the claimed invention would have been obvious to those skilled in the art in light of the knowledge made available by the references. *In re Donovan*, 184 USPQ 414, 420, n. 3 (CCPA 1975). It requires consideration of the entirety of the disclosures of the references. *In re Rinehart*, 189 USPQ 143, 146 (CCPA 1976). All limitations of the claims must be considered. *In re Boe*, 184 USPQ 38, 40 (CCPA 1974). In making a determination as to obviousness, the references must be read without benefit of

Applicants' teachings. *In re Meng*, 181 USPQ 94, 97 (CCPA 1974). In addition, the propriety of a §103 rejection is to be determined by whether the reference teachings appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed substitution, combination, or other modifications. *In re Lintner*, 173 USPQ 560, 562 (CCPA 1972). A reference which teaches away from the Applicants' invention may not properly be used in framing a 35 U.S.C. §103 rejection of Applicants' claims. See *United States v. Adams*, 148 USPQ 479, 484 (1966).

A basic mandate inherent in §103 is that a piecemeal reconstruction of prior art patents shall not be the basis for a holding of obviousness. It is impermissible within the framework of §103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. *In re Kamm*, 172 USPQ 298, 301-302 (CCPA 1972).

When determining the patentability of a claimed invention which combines two known elements, the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination. *Ecolochem Inc. v. Southern California Edison*, 56 USPQ2d 1065, 1073 (Fed. Cir. 2000). In other words, there must be something in the teachings of cited references to suggest to an individual skilled in the art that a claimed invention would have been obvious. *W. L. Gore and Associates v. Garlock, Inc.*, 220 USPQ 303 (Fed. Cir. 1983). This position was reaffirmed in the case of *Arkie Lures, Inc. v. Gene Larew Tackle, Inc.*, 43 USPQ 2d 1294 (Fed. Cir. 1997). *Arkie Lures* involved the combination of a plastic fishing lure with salt materials to yield a highly attractive lure product. The prior art disclosed both concepts (salty bait and plastic lures)

separately but not in combination. The CAFC ultimately held that the invention under consideration was not obvious. Even though both of the claimed features were disclosed by the cited art, the CAFC concluded that this was insufficient to prove a case of obviousness in the absence of a teaching or suggestion in the art to combine the references.

Likewise, the requirement that a concrete suggestion be present in the cited art for a proper obviousness rejection to be made is even further supported by *C.R. Bard Inc. v. M3 Systems Inc.*, 48 USPQ 2d 1225 (Fed. Cir. 1998). This case involved an allegation that a particular medical needle apparatus was merely a product of "obvious modifications" to a prior needle assembly. The CAFC disagreed and stated that the claimed invention was neither suggested nor taught by the prior art, and further indicated that the "invention that was made, however, does not make itself obvious; that suggestion or teaching must come from the prior art" itself. 48 USPQ 2d at 1232 (emphasis added). The CAFC also concluded that the requisite suggestion or teaching was so important that, in its absence, the claimed invention could not have been obvious. According to the court, "Absent this essential evidentiary component of an obviousness holding, as a matter of law the verdicts of invalidity on that ground cannot stand. Consequently, the judgment of invalidity based on obviousness is reversed." 48 USPQ 2d at 1232.

Rejection of Claims 7-11 and 14

As noted above, claims 7-11 and 14 were rejected under 35 U.S.C. §103(a) as being unpatentable over Munro '317 in view of McCormack et al. '574 and Allen '282". Claim 14 has been cancelled, and claim 7 has been amended above.

Applicants believe that claims 7-11 are now allowable over the cited references for the following reasons.

None of the cited art, either alone or in combination, discloses or suggests Applicants' claim 7:

7. (Currently amended) A mounting device for securing an electronic device comprising at least one opening to an equipment rack comprising a plurality of openings, comprising:

- a) a mounting member comprising at least one flange, an opening extending at least partially around the circumference of said mounting member, an end portion received within said at least one opening in said electronic device, and an inner cylindrical portion that receives at least a first fastener and a second fastener, said first fastener having a different thread type than said second fastener;
- b) a retainer member that is received by said opening in said mounting member, said retainer member having a smaller diameter portion engaged with said first fastener or said second fastener in a latched mode which prevents one of said first fastener and said second fastener from being removed from said mounting member, and said retainer member having a larger diameter portion that is positioned adjacent to said first fastener or said second fastener in an unlatched mode which allows one of said first fastener and said second fastener to be removed from said mounting member and the other of said first fastener or said second fastener to be inserted into said mounting member while securely retaining said retainer member within said opening in said mounting member; and

c) a securing device mounted on said end portion of said mounting member which secures said mounting member to said electronic device and allows either of said first fastener and said second fastener to be removed from said mounting member while securely retaining said mounting member within said at least one opening in said electronic device, and that facilitates floating movement of said mounting member within said at least one opening in said electronic device.

Applicants amended claim 7 as suggested by the Examiner in the Office Action. First, Applicants removed the phrase "adapted to" and replaced it with that-. Applicants also revised the "securing device" element to specify that this device facilitates floating movement of the mounting member within the opening in the equipment rack. Finally, Applicants changed the word "receivable" in claim 7 to received- in describing the relationship between the mounting member and the electronic device. All other amendments to claim 7 were made in order to explicitly state what was believed by Applicants to be inherently present in the previously-presented version of this claim. Applicants believe that these amendments place claim 7 in condition for allowance or, alternatively, in better condition for appeal.

Munro '317 is directed to a threaded fastener retaining device (29) having an opening (20) which receives a flexible member (21) that loosely engages a threaded fastener (25) so that it will not fall out of the retaining device (29). The threaded fastener (25) utilized is of a particular type: it has a first threaded portion (26) and a second threaded portion (28) separated by a smooth, reduced shank portion (27).

Pressure on the threaded fastener (25) causes the flexible member (21) to separate and allows the threaded fastener (25) to be inserted into or removed from the retaining device (29).

McCormack et al. '574 is directed to a captive screw (202) having a flange (214) on its head (208) that retains the screw (202) within the hollow bore (216) of a ferrule (204). The particular screw (202) that is enclosed within the ferrule (204) is "captive" and may not be removed from the ferrule (204).

Allen '282 is directed to a rack mount panel fastener that is adapted to receive screws (54, 65) of different thread sizes. A screw (54, 65) is received within a ferrule (46) and is secured on the opposite side of a panel (40) with a mating retainer (64, 66) that is appropriate for the size of the screw (54, 65).

None of the cited references, either alone or together, discloses a mounting device wherein fasteners with different threads can be swapped out while securely retaining the retainer member within an opening in the mounting member and securely retaining the mounting member within an opening in the electronic device. (Applicants' claim 7, element b and c). Such a feature substantially facilitates mounting an electronic device to an equipment rack because the mounting member remains firmly in place on the electronic device while its fasteners are being swapped out (instead of being removed or falling out and possibly getting lost), and the retainer member need not be taken out and set aside (also possibly getting lost). First, Allen '282 does not disclose any type of retainer member, much less one that is securely retained within an opening in the mounting member while fasteners with different threads are swapped out. With regard to Applicants' mounting member, on page 11 of the Office Action, the Examiner equates the ferrule (46) of Allen '282 with Applicants' mounting member. The Examiner also states that Allen '282 discloses a

fastener system comprising two fasteners (54, 65) having different thread types that alleviates the problem of an equipment rack having threaded openings that differ from that within an electronic device (panel 40), without using an adapter interface or removing the ferrule (46) from the electronic device (panel 40). With the Allen '282 device, while the ferrule (46) need not be "removed" from the electronic device, it most certainly could fall out when a fastener (54, 65) is removed therefrom since, with the fastener (54, 65) removed, there is no longer anything holding the ferrule (46) to the electronic device (panel 40). In other words, the ferrule (46) of Allen '282 is not securely retained on the electronic device (panel 40). Thus, Allen '282 does not disclose or suggest Applicants' "securing device" that allows a fastener to be removed from the mounting member while securely retaining the mounting member within an opening in the electronic device. The only "securing device" disclosed in Allen '282 is a retainer (64, 66) that is mounted on the fastener (54, 65), not the ferrule (46) (or mounting member), which clearly must be removed when a fastener (54, 65) is removed from the ferrule (46). Thus, if the fastener is removed from the ferrule (46), the retainer (64, 66) could not retain the ferrule (46) within an opening in electronic device (panel 40).

Neither of the other cited references (Munro '317 and McCormack et al. '574) is directed to the problem solved by Applicants' invention. Clearly, neither reference discloses or suggests a mounting device wherein fasteners with different threads can be swapped out while securely retaining the retainer member within an opening in the mounting member and securely retaining the mounting member within an opening in the electronic device (Applicants' claim 7, elements a and c). On page 3 of the Office Action, the Examiner states that since Munro '317 discloses a single fastener (25) having a shank (27) including two possibly different thread types (26,

28), it is "inherent" that its mounting member (housing 17) is "adapted to" (this language having been removed from claim 7 in the present Amendment) accept various thread types. However, Munro '317 does not suggest swapping out its fastener (25) with another fastener, nor does this reference provide any suggestion as to how its mounting member (housing 17) could possibly be retained on the flange (11) when its fastener (25) is removed. In other words, Munro '317 does not disclose or suggest a "mounting member" or a "securing device" as claimed in Applicants' claim 7 (elements a and c). Like Allen '282, the only "securing device" disclosed in Munro '317 is a nut (16) that is mounted on the fastener (25), not the housing (17), which must be removed before the fastener can be removed. Thus, the nut (16) does not retain the housing (17) within an opening in an electronic device (or any other type of device) when the fastener (25) is removed.

Furthermore, Munro '317 does not disclose or suggest a "retainer member" as claimed in Applicants' claim 7 (element b). On page 4 of the Office Action, the Examiner states that (emphasis added), "...Applicant has not provided a convincing argument that there is a substantial different in function between the retaining member (21) discussed by Munro, and the retaining member disclosed in the instant claim 7...." However, there are significant differences in structure between the Munro '317 retaining member (21) and Applicants' retainer member as claimed in amended claim 7. For example, Applicants' retainer member has a smaller diameter portion engaged with the fastener in a latched mode which prevents the fastener from being removed from the mounting member. The flexible retaining member (21) of Munro '317 actually allows the fastener (25) to be removed by simply turning the fastener (25), thereby separating the legs (24) of the flexible retaining member (21) which increases the diameter of the bowed-out portion (23) of the member (21) (see

col. 3, lines 7-11). The flexible retaining member (21) therefore does not have a smaller diameter portion engaged with the fastener in a latched mode that prevents the fastener from being removed from the mounting member. As noted above, in rejecting a claim based on 37 U.S.C. §103, all limitations of the claims must be considered. *In re Boe*, 184 USPQ 38, 40 (CCPA 1974).

With regard to McCormack et al. '574, as noted above, this reference also does not disclose or suggest a mounting device wherein fasteners with different threads can be swapped out while securely retaining the retainer member within an opening in the mounting member and securely retaining the mounting member within an opening in the electronic device (Applicants' claim 7, elements a and c). This reference actually teaches away from Applicants' invention since it is directed to a captive screw that clearly cannot and would not be swapped out with another fastener. As discussed above, a reference that teaches away from the Applicants' invention may not properly be used in framing a 35 U.S.C. §103 rejection of Applicants' claims. See *United States v. Adams*, 148 USPQ 479, 484 (1966). Furthermore, McCormack et al. '574 does not disclose or suggest any type of "retainer member", much less Applicants' retainer member as claimed in claim 7, element b.

Since none of the cited references disclose the retainer member and securing device Applicants' claim 7, element b and c, even all of the references considered together would not provide Applicants' invention as claimed in claim 7. For at least this reason, Applicants believe that claim 7 is allowable.

Finally, since neither Munro '317 nor McCormack et al. '574 presents any suggestion to provide a mounting device that is capable of holding different-sized screws, nor do they even suggest the desirability of doing so, it would not be obvious

to combine these references with Allen '282 in an attempt to create Applicants' invention as claimed in claim 7. In this regard, on page 3 of the Office Action the Examiner cites *In re Bozek*, 163 USPQ 545, 549 (CCPA 1969) as holding that a conclusion of obviousness may be based on common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference. However, subsequent decisions have held otherwise. The court specifically discussed the holding in the *Bozek* case in *In re Lee*, 61 USPQ2d 1430, 1435 (Fed. Cir. 2002) (emphasis added):

The case on which the Board relies for its departure from precedent, *In re Bozek* [citation removed], indeed mentions "common knowledge and common sense," the CCPA stating that the phrase was used by the Solicitor to support the Board's conclusion of obviousness based on evidence in the prior art. *Bozek* did not hold that common knowledge and common sense are a substitute for evidence, but only that they may be applied to analysis of the evidence. *Bozek* did not hold that objective analysis, proper authority, and reasoned findings can be omitted from Board decisions. **Nor does Bozek, after thirty-two years of isolation, outweigh the dozens of rulings of the Federal Circuit and the Court of Customs and Patent Appeals that determination of patentability must be based on evidence.** This court has remarked, in *Smiths Industries Medical Systems, Inc. v. Vital Signs, Inc.* [citation removed], that *Bozek*'s reference to common knowledge "does not in and of itself make it so" absent evidence of such knowledge.

Thus, in accordance with the current state of the law discussed above, when determining the patentability of a claimed invention which combines two known elements, the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination. *Ecolochem Inc. v. Southern California Edison*, 56 USPQ2d 1065, 1073 (Fed. Cir. 2000). In other words, there must be something in the teachings of cited references to suggest to an individual skilled in the art that a claimed invention would have been obvious. *W. L. Gore and Associates v. Garlock, Inc.*, 220 USPQ 303 (Fed. Cir. 1983); *Arkie Lures, Inc. v. Gene Larew Tackle, Inc.*, 43 USPQ 2d 1294 (Fed. Cir. 1983).

1997). A concrete suggestion must be present in the cited art for a proper obviousness rejection to be made. *C.R. Bard Inc. v. M3 Systems Inc.*, 48 USPQ 2d 1225 (Fed. Cir. 1998).

Neither Munro '317 nor McCormack et al. '574 disclose a mounting member having an inner cylindrical portion that receive fasteners of different thread types. Munro '317 discloses only a particular threaded fastener having a smooth shank portion (27) between threaded portions (26, 28), and does not suggest any other threaded fasteners. McCormack et al. '574 discloses a captive screw (202), which clearly does not allow interchangeability with different-sized screws. The only cited reference that discloses a mounting member (ferrule 46) adapted to receive different-sized screws is Allen '282. However, Allen '282 does not disclose the invention of Applicants' claim 7 as discussed above. Since neither Munro '317 nor McCormack et al. '574 presents any suggestion to provide a mounting device that is capable of holding different-sized screws, nor do they even suggest the desirability of doing so, it would not have been obvious to combine these references with Allen '282 in an attempt to create Applicants' invention as claimed in claim 7.

In view of the above, Applicants' claim 7 is believed to be allowable. Dependent claims 8-11 are also believed to be allowable as depending from an allowable base claim, and further because of the novel and nonobvious combination of elements contained therein. Claim 14 has been cancelled.

Rejection of Claims 12 and 13

As noted above, claims 12 and 13 were rejected under 35 U.S.C. §103(a) as being unpatentable over Allen '282 in view of Swan '100. Applicants believe that

these claims are now allowable over the cited references for the reasons discussed below.

None of the cited art, either alone or in combination, discloses or suggests

Applicants' claim 12:

12. (Currently amended) A method of mounting an electronic device having a first fastener attached thereto to an equipment rack adapted to receive a second fastener, said first fastener having a different thread type than said second fastener, comprising:

- a) providing at least one mounting device, each mounting device comprising a mounting member that receives at least said first fastener or said second fastener;
- b) for each mounting device, removing said first fastener from said mounting member while securely retaining said mounting member within said at least one opening in said electronic device;
- c) for each mounting device, inserting said second fastener into said mounting member;
- d) for each mounting device, inserting said second fastener positioned within said mounting member into an opening in said equipment rack; and
- e) for each mounting device, securing said second fastener to said equipment rack.

Applicants have amended claim 12 as the Examiner has suggested in the Office Action by removing the phrase "adapted to" and replacing it with --that--. Applicants also changed the phrase "without removing said mounting device from said electronic device" to --while securely retaining said mounting member within

said at least one opening in said electronic device—. Applicants believe that the latter phrase more accurately states the limitation contained within the previous phrase and that this Amendment places claim 12 in condition for allowance or, alternatively, in better condition for appeal. Applicants also corrected a grammatical error in claim 12, replacing "into" with —within—.

Swan '100 is directed to a retaining clip system (20) for retaining an article against a mounting surface. A stud (30) is received within a hole (80) in a housing (40). A retaining pin (50) is received within a recess (66) in the housing (40). The stud (30) has an annular channel (37) that is adapted to receive the retaining pin (50), which holds the stud (30) to the housing (40). In use, the stud (30) is passed through an opening in an article and is attached to a mounting surface, and then the stud (30) is passed through the hole (80) in the housing (40), where it is latched by the retaining pin (50).

Neither Allen '282 nor Swan '100 discloses or suggests removing a first fastener from a mounting member while securely retaining the mounting member within an opening in an electronic device (Applicants' claim 12, element b). The arguments above regarding claim 7 (elements a and c) and Allen '282 are herein renewed. As noted above, with the Allen '282 device, while the ferrule (46) need not be "removed" from the electronic device, it most certainly could fall when a fastener (54, 65) is removed therefrom since, with the fastener (54, 65) removed, there is no longer anything holding the ferrule (46) to the electronic device (panel 40). In other words, the ferrule (46) is not securely retained within an opening on the electronic device (panel 40) when a fastener (54, 65) is removed. With regard to Swan '100, as noted above, the stud (30) is passed through an opening in an article and is attached to a mounting surface, and then the stud (30) is passed through the hole

(80) in the housing (40), where it is latched by the retaining pin (50). Clearly, removal of the stud (30) would allow the housing (40) to fall, similarly to the ferrule (46) of Allen '282. Thus, neither Allen '282 nor Swan '100 discloses or suggests removing a first fastener from a mounting member while securely retaining the mounting member within an opening in an electronic device (Applicants' claim 12, element b).

For at least this reason, Applicants believe that claim 12 is allowable. Dependent claim 13 is also believed to be allowable as depending from an allowable base claim, and further because of the novel and nonobvious combination of elements contained therein.

Conclusion

For at least the reasons discussed above, Applicants believe that all of the pending claims (claims 7-13) are allowable over the cited references. Therefore, Applicants respectfully request that the Examiner reconsider the application and grant an early allowance.

Should there be any questions regarding this Amendment, the Examiner may contact Applicants' attorney at the telephone number listed below.

Respectfully submitted,

KLAAS, LAW, O'MEARA & MALKIN, P.C.

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